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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,115	02/12/2002	Shuang Chu Tsai		2330

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06/02/2004

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TAIWAN

EXAMINER

MUSSER, BARBARA J

ART UNIT

PAPER NUMBER

1733

DATE MAILED: 06/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.	Applicant(s)
10/073,115	TSAI, SHUANG CHU
Examiner	Art Unit
Barbara J. Musser	1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
 Period for Reply

## A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1 and 2 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether one or two elastomers are formed as the claim states forming the elastomer and the gasbag and then trimming and then states forming them in more detail again. It is suggested that line 3 of claim 1 be deleted. It is unclear when the sheet wraps around the elastomer as the specification appears to indicate that the film is wrapped over the elastomer as soon as the mold is closed since the mold presses the layers together.

### *Claim Objections*

3. Claim 1 is objected to because of the following informalities: multiple grammatical errors are present throughout the claim. Examples include in line 9 "a mold of forming gasbag" which should be --a mold for forming said gasbag--, in line 11, "fed in cylindrical plastic film into" which should be --feeding cylindrical plastic film into--, and in line 15, "sheet be extracted" which should be --sheet is extracted--. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chee(U.S. Patent 5,918,383) in view of Hopperdietzel(U.S. Patent 4,911,878), McLaughlin, and Pavesi et al.(U.S. Patent 5,987,781).

Chee discloses forming a shoe insert by molding an inner element and then encasing it in thermoplastic sheets to anchor the element in the casing.(Figure 5; Col. 3, ll. 33-43) It does not disclose the encasing to occur by feeding a tubular film around the inner element which is held in place in the mold via a positioning device but appears to use two thermoplastic sheets. Hopperdietzel discloses forming a reinforcement for athletic equipment(Col. 2, ll. 64) by placing the reinforcement on a positioning rod and placing it between the two halves of a mold. Material is extruded as a tubular preform around the reinforcing member.(Col. 5, ll. 6) The mold is then closed and the gas forced between the reinforcement and the extruded material, forcing the material against the mold walls. The positioning rod is withdrawn and the product is formed.(Figure 3; Col. 5, ll. 32-66) It would have been obvious to one skilled in the art at the time the invention was made to form the shoe insert of Chee et al. via the method of Hopperdietzel since this would prevent the insert from moving around inside the gasbag(Col. 2, ll. 1-3) particularly since McLaughlin discloses inserts can be surrounded

by either two thermoplastic films welded together or by a film not having weld lines, i.e. a tubular film.(Figure 5)

The reference cited above do not disclose how the elastomeric insert is formed. Pavesi et al. discloses it is known to form elastomeric inserts for shoes such as those of Chee by injection molding.(Figure 4; Col. 4, ll. 36-37, 53)) It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the insert of Chee. by injection molding since Chee is silent as to the method of formation and since Pavesi et al. discloses it is known to form elastomeric inserts for shoes by injection molding.(Col. 3, ll. 40-44)

While the reference does not require vacuum to pull the material against the mold walls, such is well-known and conventional in the molding arts. It would have been obvious to one skilled in the art at the time the invention was made to use vacuum to pull the material against the mold walls in addition to pressing them with air since such is well-known and conventional in the art.

Although Hopperdietzel does not specifically disclose trimming the margins of the outer bladder, Figure 5 shows material external to the mold which is not shown in the final product.(Figures 8-10) Thus one in the art would understand that the outer bladder was trimmed to remove excess material.

Regarding claim 2, one in the art would appreciate that a tubular preform has two open ends which must be sealed to form a sealed product. Hopperdietzel discloses a pressed periphery around the positioning rod. Since the plastic bonds to itself under

heat, one in the art would appreciate that the mold would be heated to press and bond the thermoplastic to itself.

### ***Response to Arguments***

6. Applicant's arguments filed 3/17/04 have been fully considered but they are not persuasive.

Regarding applicant's argument that Pavesi et al. and McLaughlin are directed to the structure of the elastic pad, and not the method of production, one in the art would look to related methods of placing inserts inside compartments when the references are silent as to the specifics of the formation.

7. In response to applicant's argument that Hopperdietzel is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the reference is reasonably pertinent to applicant's problem, namely encasing an insert in a film so that the seals of the film surrounding the insert do not break and so that the insert is firmly bonded to the encasing material.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Barbara J. Musser** whose telephone number is **(571) 272-1222**. The examiner can normally be reached on Monday-Thursday; alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on (571)-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

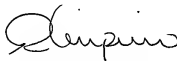
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



BJM



RICHARD CRISPINO  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700